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Serial No. 09/975,101
Amendment dated Sept. 4, 2003
Reply to Office action of May 7, 2003

Remarks

Claims 1-20 were filed in this case. Claim 20 was previously withdrawn from consideration. Claims 15 and 18 are cancelled by this amendment. Claims 1, 7, 8, 12, 16 and 17 are amended. Claims 21 through 23 are newly presented. The current claim amendments are not occasioned by the prior art, rather they are made to more particularly point out and distinctly claim Applicant's invention. New claim 23 is directed to a method of covering a hand-held electronic device. As generic claims 1, 8, and 21 should now be in a condition for allowance, new claim 23 should also be allowable.

Rejection Under 35 U.S.C. 112

The Examiner has rejected claim 7 under 35 USC 112, second paragraph, because the wording "said applicator" lacks antecedent basis. Applicant thanks the Examiner for bringing this informality to Applicant's attention. The present amendment to claim 7 should remedy this informality.

Rejection Under 35 U.S.C. 102

The Examiner has rejected claims 1, 2, 4, 5, 7-9, 11, 12, 14 and 19 under 35 USC 102(b) as being anticipated by U.S. Pat. No. 5,056,932 to Young. Applicant respectfully traverses this refusal.

Claims 1 and 8 have been amended to more particularly point out that the sleeve and/or applicator of the present invention is configured to allow selective removal of the electronic device from the sleeve. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. First, Young does not expressly or inherently teach that bag or applicator is capable of receiving an electronic device. In particular, the applicator in Young is a funnel, which is tapered so that lower portion which is inserted into the bag is narrower than the upper portion,

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which is exposed. (See Fig. 2 and Col. 4, ll. 25-28.) It is respectfully submitted that receiving an electronic device is not an inherent feature of a funnel.

Further, Young does not teach selective removal of the contents of the bag disclosed therein. To the contrary, Young teaches the permanent disposal of the contents of the bag. The bag in Young is specifically directed to a bag for the disposal of human vomitus. Thus, it is undesirable to remove the contents of the bag. In fact, Young teaches a means for preventing removal or excretion of the bags contents. (Col. 3, ll. 62-64.) Thus, the Young reference cannot anticipate any of claims 1, 2, 4, 5, 7-9, 11, 12, 14 and 19 because it fails to teach each and every limitation of these claims.

In light of the foregoing, it is respectfully submitted that the rejection under 35 USC 102(b) be withdrawn.

Rejection Under 35 U.S.C. 103

The Examiner has rejected claims 3, 6, 10, 13, 15-18 under 35 U.S.C. 103 as being obvious over Young in view of U.S. Pat. No. 4,838,327 to Ambler. Applicant respectfully traverses this refusal.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP §2143; *see also, In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Young and Ambler do not teach all of the limitations of the claims. All of the claims rejected under 35 USC §103 depend from independent claims 1 or 8. Claims 1, 8 and newly presented claim 21 recite that the sleeve and/or adapter are configured such that the electronic device is selectively removable from the sleeve. As explained above, the bag taught in Young is designed to prevent removal of the contents of the bag. Similarly, the bag assembly in

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Ambler teaches closing the bag "to prevent the loss of any material deposited in the bag." (Col. 2, ll. 21-23).

In fact, both Young and Ambler teach away from the inventions recited in the claims. As explained above, both of the cited references teach the importance of means to prevent release of the contents of the bags. Young teaches a bag for collecting human vomitus. Ambler teaches a bag for disposal of tampons and the like. In both cases, it would be undesirable to remove the contents from the bag. This teaches away from selective removal of the electronic device from the bag. Because "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention," the Ambler and Young references cannot be combined to render the present invention obvious. MPEP §2141.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied* 469 U.S. 851 (1984).

Moreover, the citation of the Young and Ambler references is improper because both patents are non-analogous to the claimed invention. "In order to rely on a reference as the basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); MPEP §2141.01(a). The Young and Ambler references would not logically have come to the inventor's attention in considering the problem of touching potentially unsanitary electronic devices. The Young and Ambler references are for the permanent encasement and disposal of certain items or bodily fluids. The present invention is directed to covering a hand-held electronic device while still allowing the use of that electronic device and allowing the electronic device to be selectively removed from the covering sleeve. This difference in function should preclude the combination of the Young and Ambler references to make a rejection under 35 USC §103.

With respect to claims 3 and 10, neither reference teaches that the sleeve is transparent. In fact, considering that the purpose of the bags in Young and Ambler are for the disposal of vomit and tampons respectively, it would be undesirable for the bags to be transparent. Thus,

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both Young and Ambler teach away from a transparent bag. Thus, the rejection under 35 USC §103 as to these claims should be withdrawn.

With respect to claims 6 and 13, contrary to the Examiners suggestion, the Ambler reference does not teach that the applicator is releasably secured to the sleeve opening. In fact, Ambler teaches that the "insert 14 is restrained from being completely withdrawn from out of the bag." (*See e.g.*, Col. 3, ll. 28-32.) As such, the rejection under 35 USCO §103 as to these claims should be withdrawn.

With respect to claims 16 and 17, these claims depend from claim 8, and should be patentable based on the arguments made with respect to claim 8.

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In view of the above, it is respectfully submitted that claims 1 through 14, 16, 17, 19, and 21 through 23 are in condition for allowance. Allowance of the claims is respectfully requested.

Respectfully submitted,
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